

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed January 10, 2005. Applicants appreciate the Examiner's consideration of this Response. Claims 1-26 are pending in the present Application. Claim 26 is allowed, Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, and 25 are rejected, and Claims 5, 8, 13, 16, 21, and 24 are objected to. For at least the reasons discussed below, Applicants respectfully request reconsideration and allowance of all pending claims.

Allowable Subject Matter

Applicant notes and appreciates the Examiner's allowance of Claim 26 and the Examiner indication that Claims 5, 8, 13, 16, 21, and 24 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Claims 5, 8, 13, 16, 21, and 24 depend from one of independent Claims 1, 9, and 17, which Applicants respectfully submit are allowable. Accordingly, Applicants have not amended Claims 5, 8, 13, 16, 21, and 24.

Rejections Under 35 U.S.C. § 102

The Examiner rejects Claims 1-4, 6, 7, 9-12, 14, 15, 17-20, 22, 23, and 25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2002/0188528 by Adelman et al. ("*Adelman Publication*"). The Examiner also rejects Claims 1-4, 6, 7, 9-12, 14, 15, 17-20, 22, 23, and 25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Provisional Patent Application No. 60/279,421 by Adelman ("*Adelman Provisional*"), filed on March 29, 2001.

With respect to the rejection over the *Adelman Publication*, Applicants appreciate the Examiner's identification of passages in the *Adelman Provisional* which the Examiner asserts provide support for the subject matter relied upon in the *Adelman Publication* to reject the claims of the present application. Applicants address this rejection over the *Adelman Publication* below. However, the present Office Action also adds a section 102(e) rejection over the *Adelman Provisional* alone. Such a rejection is improper. Section 102(e) recites the following:

"A person shall be entitled to a patent unless—

...

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

Thus, as indicated in section 102(e), a rejection using a patent application is only proper if that application is *published* under section 122(b), which a *provisional* patent application is not. Therefore, for purposes of responding to this Office Action, Applicants will treat the Examiner's rejection of the claims over the *Adelman Provisional* simply as the Examiner's assertion of the support required by M.P.E.P. § 2136.03(III) for the Examiner's rejection of the claims over the *Adelman Publication*.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (*emphasis added*).

Independent Claim 1 of the present application recites the following:

A computer-implemented method for mapping between part numbers that are based on different part numbering schemes, comprising:
receiving a first part number associated with an item, the first part number associated with the item being defined according to a first part numbering scheme;
searching a database for one or more second part numbers that are associated with the item and also cross-referenced to the first part number associated with the item, the one or more second part numbers associated with the item being defined according to one or more corresponding second part numbering schemes; and

in response to identifying the one or more second part numbers associated with the item, searching a database for a third part number that is associated with the item and also cross-referenced to at least one second part number associated with the item, the third part number associated with the item being defined according to a third part numbering scheme, the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.

Independent Claims 9, 17 and 25 recite similar, although not identical, limitations.

Claim 1 is allowable (as well as Claims 9, 17 and 25) at least because the *Adelman Publication* does not disclose “in response to identifying the one or more second part numbers associated with the item, searching a database for a third part number that is associated with the item and also cross-referenced to at least one second part number associated with the item, the third part number associated with the item being defined according to a third part numbering scheme, the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.” For the teaching of this limitation, the Examiner offers a passage in the *Adelman Publication* that teaches automatically mapping internal part numbers to manufacturer part numbers. (*Adelman Publication*, p. 2, paras. 20-21). In particular, the Examiner states that the passage teaches “automatically mapping saved part numbers (more than one part numbers) when a corresponding manufacturer part number becomes known.” Office Action, Page 3.

Applicants submit that the Office Action fails to consider each and every word of Claim 1. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). In judging the patentability of Claim 1, the Office Action fails to consider at least the phrase “the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.” More particularly, the Office Action fails to consider at least the phrase “through the at least one second part number associated with the item.”

The *Adelman Publication* merely teaches directly mapping between internal part numbers and manufacturer part numbers. (*Adelman Publication*, p. 4, para. 48; p. 2, paras. 20-21). Even assuming for the sake of argument that the passage cited by the Examiner teaches mapping a single internal part number to multiple different manufacturer part numbers as asserted by the Examiner, the *Adelman Publication* suggests that the internal part number is mapped directly to each different manufacturer part number, not “through the at least one second part number associated with the item” as claimed. For example, internal part number A may be mapped directly to manufacturer part number A1 and to a second manufacturer part number A2. In this example, the system disclosed in the *Adelman Publication* would include two mappings: internal part number A to manufacturer part number A1 and internal part number A to manufacturer part number A2. Neither of these mappings are through another part number.

Independent Claims 9, 17 and 25 recite limitations that are similar, although not identical, to the limitation of Claim 1 discussed above. Therefore, these claims are allowable for reasons analogous to those discussed above in connection with Claim 1. Furthermore, Claims 2-8, 10-16, 18-24 each depend from one of independent Claims 1, 9 or 17 and are thus also patentable over the cited art. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1-25.

In addition to depending from an allowable independent claim, Claims 2, 10, 18 are also allowable because the *Adelman Publication* clearly does not disclose that “the first part number comprises a customer part number and the first part numbering scheme comprises a part numbering scheme of a corresponding customer; each second part number comprises a manufacturer part number and each second part numbering scheme comprises a part numbering scheme of a corresponding manufacturer; and the third part number comprises an internal part number and the third part numbering scheme comprises an internal part numbering scheme of a corresponding seller,” as recited by Claim 2 (and as similarly recited in Claims 10 and 18). With regard to Claim 2, the Examiner cites to three different passages in the *Adelman Publication* that are all referring to the same thing – a mapping between an internal part number and a manufacturer part number. For example, the Examiner cites to Figures 8 and 9 of the *Adelman Publication* for a disclosure of “customer part numbers,” but

the description associated with those figures clearly indicates that it is referring to internal part numbers and manufacturing part numbers (i.e., fields 91 and 97 are clearly identified as being associated with internal part numbers). Furthermore, the part numbers begin referred to in the description of Figures 8 and 9 are the same part numbers that are identified in paragraphs 20-22. It is unclear why the Examiner asserts that one of these passages teaches customer part numbers while the other teaches internal parts numbers. Again, the *Adelman Publication* only discloses two types of part numbers – internal part numbers and manufacturer part numbers. Furthermore, the *Adelman Publication* certainly does not disclose customer, manufacturer, and internal part numbers having the relationship as the first, second, and third part numbers recited in Claim 1. For at least these additional reasons, Applicants respectfully request reconsideration and allowance of Claims 2, 10, and 18.

Furthermore, Claims 3, 11, and 19 are also allowable because the *Adelman Publication* does not disclose that the third part number comprises a universal part number and that the third part numbering scheme comprises a universal part numbering scheme. The Examiner asserts that Figure 10 discloses this limitation; however, Figure 10 refers to the same manufacturer part numbers that are discussed in conjunction with the rest of the figures. There is simply no disclosure that these are universal part numbers of a universal part numbering scheme. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 3, 11, and 19.

CONCLUSION

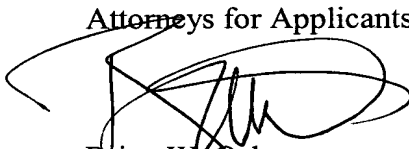
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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